

## **REMARKS**

Claims 1 to 13 are pending in the present application. Claim 1 has been amended and no new claims are added. Applicants wish to thank the Examiner for indicating that claims 1 to 9 and 13 are allowable subject matter. In order to advance prosecution and put this application in condition for allowance, claims 10 to 12 have been cancelled.

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendment and the following remarks is respectfully requested.

### **I. Rejection of Claim 10 to 12 under 35 U.S.C. § 112, First Paragraph**

Claim 10 to 12 were rejected under 35 U.S.C. § 112, first paragraph. Based on the above amendment, Applicants respectfully assert that these rejections are moot.

Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

### **II. Rejection of Claims 1 and 8 under 35 U.S.C. § 112, Second Paragraph**

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, because the wording of moiety A is allegedly ambiguous. According to the Office Action, it is unclear as to what kind of ring is fused to the second ring. Applicants respectfully traverse this rejection as the language of claim 1 is clear and conveys a definite meaning to one skilled in the art.

Support for the bicyclic substituent of A in question is provided in the specification, *inter alia*, on page 8, lines 6 to 9, and in examples throughout the specification and the claims as filed. In order to advance prosecution, claim 1 has been amended to describe the substituent as bicyclic, in nomenclature similar to the description of other bicyclic groups in the specification and claims.

In view of the above amendment, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph, for allegedly being broader in scope than claim 1 from which claim 8 depends. Applicants respectfully traverse the rejection as claim 8 is not of broader scope than claim 1.

Claim 1 claims compounds of formula (I) or a "pharmaceutically acceptable ester thereof." Claim 8 is directed to a group of pharmaceutically acceptable esters of the compounds

claimed in claim 1. Accordingly, claim 8 is not broader than claim 1 as alleged in the Office Action.

Applicants respectfully request reconsideration and withdrawal of the rejection of claim 8.

**III. Objection to Claims 2 to 7, 9 and 13.**

Claims 2 to 7, 9 and 13 were objected to as being dependent from a rejected base claim. Based on the above amendment and remarks, Applicants respectfully assert that claims 2 to 7, 9 and 13 will no longer be dependent from a rejected base claim. As such, Applicants request reconsideration and withdrawal for the objection to claims 2 to 7, 9 and 13.

Novartis  
Corporate Intellectual Property  
One Health Plaza, Building 104  
East Hanover, NJ 07936-1080  
(862) 778-7951

Respectfully submitted,



---

Peter J. Waibel  
Attorney for Applicants  
Reg. No. 43,228

Date: March 10, 2006